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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3629

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11/28/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/853,094

Applicant(s)

DEE, MARK R.

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5, 18-22 and 50-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5, 18-22, 50-91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Applicant's amendment of 9/11/07 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 50,70,20-22,56,58,62-67,77-80,85,86, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For claims 50,70, the examiner notes the language "wherein the communication means provides the central processing with....billing database.". This is a method step in an apparatus type of claim. This language is not written in a functional sense and seems to be reciting that the communication means is actually performing a step. This is improper because a claim can only fall into one statutory class of invention at one time. Ex parte Lyell 17 USPQ2d 1548 (Bd. Pat. App. & Int 1990) ; IPXL Holdings, L.L.C. v Amazon.Com, Inc., 430 F.3d 1377, 1384 (Fed. Cir. 2005).

For claims 20-22,56,58,62-67,77-80,85,86, applicant is reciting a method step of using the recited structure of the system. This is improper because a claim can only fall into one statutory class of invention at one time. This claim is dependent from an apparatus claim but is reciting a method step by using recited structure of the system, which is a mixing of two distinct statutory classes of invention. This renders the claims as non-statutory. Ex parte Lyell 17 USPQ2d 1548 (Bd. Pat. App. & Int 1990) ; IPXL Holdings, L.L.C. v Amazon.Com, Inc., 430 F.3d 1377, 1384 (Fed. Cir. 2005).

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3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 50,70,20-22,56,58,62-67,77-80,85,86, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 50,70,20, one wishing to avoid infringement would not know the scope of the claim. The reason is that one wishing to avoid infringement would not know whether or not they were infringing by just possessing the claimed structure of the invention, or if they were infringing only when using the claimed device in the claimed manner. The claim is indefinite for this reason. Correction is required. Ex parte Lyell 17 USPQ2d 1548 (Bd. Pat. App. & Int 1990) ; IPXL Holdings, L.L.C. v Amazon.Com, Inc., 430 F.3d 1377, 1384 (Fed. Cir. 2005).

For claims 21,22,56,58,62-67,77-80,85,86, one wishing to avoid infringement would not know the scope of the claim. The reason is that one wishing to avoid infringement would not know whether or not they were infringing by just possessing the claimed structure of the invention, or if they were infringing only when using the claimed device in the claimed manner. The claim is indefinite for this reason. The examiner notes that applicant changed the claim from reciting functional language to now reciting the actual performing of the step. Ex parte Lyell 17 USPQ2d 1548 (Bd. Pat. App. & Int 1990) ; IPXL Holdings, L.L.C. v Amazon.Com, Inc., 430 F.3d 1377, 1384 (Fed. Cir. 2005).

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5,18-22,50-58,60-86,88-91, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ouimet et al. (WO 97/37328) in view of Zeitman (WO 98/04080) and further in view of Maropis et al. (20020061092).

For claims 50,57,60,61,62,63,66,67, Ouimet discloses a parking payment system. There is inherently a vehicle, an occupant, a space and a location as claimed. The claimed reference identifier is considered to be the motorist "smart card" that is disclosed by Ouimet on page 6; however, it is not disclosed that the motorist smart card has wireless communication means as is claimed in claim 50. The wireless ticket issuance device is 18, and communicates with a central processing means 16. The parking meter is 12 and has wireless communication means 41. The parking meter and the central processing means can credit the central processing means with payment received as claimed. The central processing means (computer 16), tracks credits for payment received as claimed, records start times for parking (so you can determine when a vehicle is illegally parked due to exceeding the time paid for parking), communicates status information to the wireless ticket devices 18, and records ticket information as claimed.

Not disclosed is that there is a communication means to be used by the occupant to communicate with the central processing means. Also not disclosed is that the motorist smart card (from pg 6 of Ouimet) has wireless communication means as is claimed in claim 50. Also not disclosed is that the system is able to inform and prompt the communication means, upon expiration of time, to enter more time to credit the parking meter.

With respect to the smart card having wireless communication means, one of ordinary skill in the art would clearly recognize that smart cards can either be contact type or non contact type. The examiner takes "official notice" that it was well known in the prior art to use contactless type smart cards (with wireless communication means) in addition to using contact type of smart cards. Both were known in the art prior to the filing of the instant application. The examiner has cited examples of evidence that supports this position at the end of this office action. Taking into account that Ouimet discloses the use of a smart card (may be contactless or contact type, nothing further disclosed by Ouimet) and taking into account that one of ordinary skill in the art at the time the invention was made would have been aware of and understood the fact that smart cards also come in a contactless type that has wireless communication means, one of ordinary skill in the art would have found it obvious to use a smart card that has wireless communication means as an alternate to the contact type of smart card used in Ouimet. Both types of smart cards were known in the art and to simply use a contactless type of smart card is something that one of ordinary skill in the art would have understood and would have found obvious. A reason for doing this would be for

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the advantages that having wireless devices provides. They are easier to use in that they communicate data wirelessly. One of ordinary skill in the art would have clearly appreciated the desirability of using a smart card with wireless communication means as is claimed.

Zeitman discloses a parking management system that has a high level of user convenience. Zeitman discloses that the user can directly communicate with a central computer system by using their mobile telephone or a computer, and can provide the information such as vehicle space and time information by using their telephone. This would allow for more user convenience when conducting the parking space use transaction. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Ouimet with the ability to take user information by a communication means (telephone, computer) as is disclosed by Zeitman so that the user has another convenient method by which to conduct the parking transaction.

With respect to the last paragraph of claim 50, this is a method limitation that is not seen as defining any further structure to the claimed system. Also, this recitation is directed to non-functional descriptive material because the recited data is claimed as being sent but is never recited as being able to be used in any further manipulative manner. "For association" is not seen as a further manipulative use of the data. The number or password, etc. is directed to non-functional descriptive material.

With respect to the ability to inform and prompt the communication means to enter more time, Maropis discloses a system that can inform and prompt a customer of the impending expiration of a service. A customer is disclosed as being informed of the

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expiration of a service so that they can renew their service. The prompting can be done by calling the customer's telephone and can be done at any time as requested by the customer, see paragraph 25. This is a teaching that it is desirable to remind and inform people about an upcoming expiration of a service, so that they can take the appropriate steps to ensure continued service. This teaching is applicable to and desirable for many types of situations where a service of some kind is about to expire. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Ouimet with the ability to inform and prompt the communication means of user (which is a telephone) of the fact that their time is about to expire, so that they can add more time to avoid getting a parking violation (ticket). The combination with Zeitman already has resulted in the ability to add or credit the parking meter with time so this part of the claim language is satisfied by the prior art. With respect to the fact that the claim recites informing and prompting "upon expiration", this would also have been obvious to one of ordinary skill in the art. Maropis discloses the informing and prompting before expiration and one of ordinary skill in the art would have also found it obvious to do the informing and prompting step upon expiration as this is the point at which the service (paid parking time) has ended. Informing the user before expiration is more desirable but informing upon expiration is also considered to be obvious in view of the prior art teaching.

For claim 5, the parking location can be reference by means of geographic positioning. This claim is not reciting any further structure to the system of claim 50. The manner in which the parking location is determined is not relevant to the system.

For claims 18,56,64, the 103 rejection results in a communication means that can communicate with the central processing means to add extra time as claimed. This feature is present in the resulting structure of the 103 combination.

For claims 19,65, the communication means is fully capable of being notified as claimed. The prior art has the ability to perform the functional recitation claimed.

For claims 20,21,22, as best understood by the examiner the prior art satisfies what is claimed. This is because the time status information is verified by the ticket machine in Ouimet by acquiring data about the vehicle. The manner in which that information is obtained is not given weight in an apparatus claim because that has to do with the method of use.

For claims 51-55,68,69, the prior art rejection results in the claimed structure. This is because the communication means of Zeitman (that was provided to the system of Ouimet) is disclosed as being a telephone (cell phone or landline) as well as a computer. This can be seen figure 1 of Zeitman. A computer and/or a cell phone can be considered as personal data assistants. The disclosed telephones are considered to be paging devices.

With respect to claim 58, reciting whom it is that issued the reference identifier is not seen as reciting any further structure to the system. Claiming whom the reference identifier is issued from is not reciting any particular structure to the system or the reference identifier.

For claims 70,71,81-85,88-90, Ouimet discloses a parking payment system. There is inherently a vehicle, an occupant, a space and a location as claimed. The

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claimed reference identifier can be considered to be the motorist "smart card" that is disclosed by Ouimet on page 6, or can be any other vehicle identifying data that would identify the vehicle, such as a vehicle identification number (VIN) or even a license plate number. The specification sets forth that the reference identifier can be the VIN of the vehicle, which is just a number, so the scope of the term "reference identifier" is very broad and can be just a number and is not even required to be a real world tangible thing. The wireless ticket issuance device is 18, and communicates with a central processing means 16. The parking meter is 12 and has wireless communication means 41. The parking meter can receive credits, process payments, record payment times, etc., as claimed. The parking meter and the central processing means can credit the central processing means with payment received as claimed. The central processing means (computer 16), tracks credits for payment received as claimed, records start times for parking (so you can determine when a vehicle is illegally parked due to exceeding the time paid for parking), communicates status information to the wireless ticket devices 18, and records ticket information as claimed. With respect to the language "for communicating the reference identifier and geographical identifier number and making a payment", this is directed to the intended use of the system and is not taken as defining any further structure to the claimed system. This language has more to do with how the system is intended to be used than what the system is made up of structurally.

Not disclosed is that there is a communication means to be used by the occupant to communicate with the central processing means. Not disclosed is that the

communication means is able to obtain and display parking status and time as claimed. Not disclosed is that the parking space has a geographic identifier number. Also not disclosed is that the system is able to inform and prompt the communication means, upon expiration of time, to enter more time to credit the parking meter.

With respect to the parking space having a number, the examiner takes "official notice" that it is old and well known to have parking spaces numbered. This is nothing new. Spaces are numbered in city jurisdictions, in parking garages, in townhouse developments, etc.. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the parking space with a number, so that each space is identified by a number. That is the reason you put numbers in spaces, so the spaces are labeled in some understandable manner. This would have been obvious to one of ordinary skill in the art.

Zeitman discloses a parking management system that has a high level of user convenience. Zeitman discloses that the user can directly communicate with a central computer system by using their mobile telephone or a computer, and can provide the information such as vehicle space and time information by using their telephone. Users can also reserve parking spaces in advance by using their telephones or computers (personal data assistants, paging devices, cl 83,84). The use of a telephone provides more user convenience when conducting the parking space use transaction. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Ouimet with the ability to take user information by a communication means (telephone, computer) as is disclosed by Zeitman so that the user has another

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convenient method by which to conduct the parking transaction. With respect to the communication means being able to obtain and display the parking status and the parking meter credit time (start time), one of ordinary skill in the art would have further found it desirable to allow the user to also use the communication means to obtain parking status information as well as information on parking start time because this is information that one would reasonably find to be of interest to a person parked at a parking meter. If one were using a communication means (such as a phone) to allow a user to reserve a space and pay for parking in a space, to allow the user to also obtain parking status time (such as is provided to the parking enforcement officer in both applied references) and start time would have been something that one of ordinary skill in the art would have found obvious. Providing an update on the parking status and the parking start time is something that is within the knowledge of one of ordinary skill in the art.

With respect to the last paragraph of claim 70, this is a method limitation that is not seen as defining any further structure to the claimed system. Also, this recitation is directed to non-functional descriptive material because the recited data is claimed as being sent but is never recited as being able to be used in any further manipulative manner. "For association" is not seen as a further manipulative use of the data. The number or password, etc. is directed to non-functional descriptive material.

With respect to the ability to inform and prompt the communication means to enter more time, Maropis discloses a system that can inform and prompt a customer of the impending expiration of a service. A customer is disclosed as being informed of the

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expiration of a service so that they can renew their service. The prompting can be done by calling the customer's telephone and can be done at any time as requested by the customer, see paragraph 25. This is a teaching that it is desirable to remind and inform people about an upcoming expiration of a service, so that they can take the appropriate steps to ensure continued service. This teaching is applicable to and desirable for many types of situations where a service of some kind is about to expire. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Ouimet with the ability to inform and prompt the communication means of user (which is a telephone) of the fact that their time is about to expire, so that they can add more time to avoid getting a parking violation (ticket). The combination with Zeitman already has resulted in the ability to add or credit the parking meter with time so this part of the claim language is satisfied by the prior art. With respect to the fact that the claim recites informing and prompting "upon expiration", this would also have been obvious to one of ordinary skill in the art. Maropis discloses the informing and prompting before expiration and one of ordinary skill in the art would have also found it obvious to do the informing and prompting step upon expiration as this is the point at which the service (paid parking time) has ended. Informing the user before expiration is more desirable but informing upon expiration is also considered to be obvious in view of the prior art teaching.

For claims 72,73, not disclosed is that the reference identifier is a tag display on the vehicle, or a reference tag with a bar code. The prior art to Ouimet recognizes and discloses that vehicle identification data must be entered by the user, see page 6. The

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user must identify the vehicle and user entered data is disclosed as being provided that allows for vehicle identification. The claimed reference identifier does the same thing, it is identifying data that identifies the vehicle. When the reference identifier is a VIN, this is a number that identifies the vehicle, just like a tag with a number displayed on the vehicle would. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the reference identifier be a reference tag with identifying data, or a tag with a bar code, so that identifying data of some kind is received that would allow one to identify the parked vehicle upon visual inspection by a parking officer. Hang tags for vehicles is old and well known in the art. Additionally, the examiner notes that there is no specific problem being solved by having the reference identifier be the claimed types, and there is no unexpected result associated with their individual use, therefore, they are taken as a choice in system design. The claimed reference identifier identifies the vehicle, something that the prior art recognizes in a broad sense.

For claim 75, if one wanted to, they could make the reference identifier be a VIN. Claiming that it can be this is not the same as claiming that it is this.

For claim 76, not disclosed is that the communication means is able to add extra time by updating the central processing means during the time period claimed (assumed to be during a time when the meter still has paid time left and has not yet expired). It is well known in parking meter art that once a user parks their car, they can go back to the meter and add more money to buy more time. The examiner takes "official notice" of the fact that it is routine for people to go to a meter prior to the time

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expiring to buy more time on the meter. This is something that would have most likely taken place manually with the more well known and older types of meters that were purely mechanical. One of ordinary skill in the art who uses the communication means of Ouimet to allow a person to initially pay for parking, as the prior art rejection results in, would also find it obvious to also allow a user to utilize the communication means to purchase extra time for the meter. As stated previously, the act of adding more time to a parking meter is known in the art (although in a manual sense), and in the prior art rejection the user uses the communication means to pay for parking, so one of ordinary skill in the art would have found it obvious to also allow the user to use the communication means to pay for extra time by updating the central processing means.

For claim 77, not disclosed is that the user is notified by the central processing means that the time is about to expire. The examiner takes "official notice" that it is old and well known in the art to notify customers of the fact that something is about to expire, especially from time periods. It is well known in the art to notify an account holder that has fees automatically charged to a credit card, that their current credit card is about to expire. This is done so that the business can continue to charge fees to a valid credit card whose allowable time of use has not expired. It is also known in the art to notify customers of the fact that a time period is about to expire, like a service period for a warranty or other services. Subscribers to services are notified when their current subscription is about to expire. The overall idea of notifying a customer that something is about to expire (time period, credit card, etc.) is very well known in the art. One of ordinary skill in the art would have recognized that from the customer's standpoint, it

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would be advantageous to be notified that your time is about to expire, so that they can add extra time to the meter to avoid getting a ticket. This is something that one of ordinary skill in the art would have recognized based on common sense and the knowledge that one of ordinary skill in the art has in their possession.

For claims 74,78, Ouimet discloses that the parking warden can simply enter the license plate number of a vehicle to obtain parking status information. See page 8 last paragraph. The act of entering a reference identifier (vehicle identification data in the form of a license plate number) to obtain parking status information is disclosed by Ouimet. Clearly, if the parking warden is able to enter the license plate number to obtain the parking status information for that vehicle, then it necessarily follows that the license plate number would have to have been entered by the user at some point for purposes of vehicle identification. This satisfies what is claimed in claim 74 and claim 78.

For claim 79, when the reference identifier includes a bar code (as was addressed for claim 73, then it follows that one would enter the bar code data to obtain the parking status information. Ouimet discloses that the parking warden can simply enter the license plate number of a vehicle to obtain parking status information. See page 8 last paragraph. When a barcode is used, which is considered obvious, then it follows that one would scan the bar code to subsequently obtain the parking status for that vehicle.

For claim 80, not disclosed is that the reference identifier (i.e. the motorist smart card from pg 6 of Ouimet) has wireless communication means. One of ordinary skill in

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the art would clearly recognize that smart cards can either be contact type or non contact type. Applicant's most recent argument that a smart card does not inherently have a wireless communication means, is persuasive, but at the same time also is further evidence of the fact that smart cards can be contact type or wireless type. The examiner takes "official notice" that it was well known in the prior art to use contactless type smart cards (with wireless communication means) in addition to using contact type of smart cards. Both were known in the art prior to the filing of the instant application. The examiner has cited examples of evidence that supports this position at the end of this office action. Taking into account that Ouimet discloses the use of a smart card (may be contactless or contact type, nothing further disclosed by Ouimet) and taking into account that one of ordinary skill in the art at the time the invention was made would have been aware of and understood the fact that smart cards also come in a contactless type that has wireless communication means, one of ordinary skill in the art would have found it obvious to use a smart card that has wireless communication means as an alternate to the contact type of smart card used in Ouimet. Both types of smart cards were known in the art and to simply use a contactless type of smart card is something that one of ordinary skill in the art would have understood and would have found obvious. A reason for doing this would be for the advantages that having wireless devices provides. They are easier to use in that they communicate data wirelessly. One of ordinary skill in the art would have clearly appreciated the desirability of using a smart card with wireless communication means as is claimed.

For claim 86, the recitation of whom it is that issued the reference identifier is not something that further defines any structure to the reference identifier itself, especially in an apparatus type of claim where structure is considered and not method steps. The prior art satisfies what is claimed.

For claim 91, not disclosed is that the central processing means allows for adjustment of an amount to be charged. The examiner interprets this to be the ability of the central processing means to credit the account of a user, as opposed to charging the account of a user. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the central processing means with the ability to adjust the amount to be charged. Providing the central processing means with the ability to adjust an amount to be charged is considered obvious.

7. Claims 59,87, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ouimet et al. (WO 97/37328) in view of Zeitman (WO 98/04080) and further in view of Hassett (5351187).

For claims 59,87, not disclosed in the 103 combination is that the reference identifier is a radio frequency transponder. In Ouimet the reference identifier (the smart card that contains vehicle data and pre loaded parking funds) can be used to pay for parking by using pre-paid funds loaded onto the card. Hassett discloses a parking payment system where the user has a radio frequency transponder for their vehicle, where the transponder is preloaded with funds to be used to pay for parking. It would have been obvious to one of ordinary skill in the art at the time the invention was made

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to make the reference identifier a radio frequency transponder as disclosed by Hassett because the transponder works in the same way as the smart card of Ouimet does and is considered to be a functional equivalent to the smart card. One of ordinary skill in the art would have found the use of the transponder as obvious. The transponder is just another way to use technology to accomplish the payment of parking funds, just like the smart card of Ouimet does.

8. Applicant's arguments filed 9/11/07 have been fully considered but they are not persuasive.

With respect to the 101 rejection, the arguments are not persuasive. The claims are reciting method steps where actions are taking place in the opinion of the examiner. This is claiming a method step as part of a system claim, which is not statutory. The claims cannot recite structure of a system and then use that recited structure in a method step, this is improper. Ex parte Lyell 17 USPQ2d 1548 (Bd. Pat. App. & Int 1990) ; IPXL Holdings, L.L.C. v Amazon.Com, Inc., 430 F.3d 1377, 1384 (Fed. Cir. 2005). The examiner takes the position that claims can only fall into one statutory class of invention at one time. This position is believed to be correct and consistent with PTO policy and the cited precedent.

With respect to the 112,2nd rejection for claims 50,7020-22,56,58,63-67, is the claimed method required to infringe or not? It is not clear if infringement would occur by just having the system, or if the system were to operate as is claimed in these claims.

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Ex parte Lyell 17 USPQ2d 1548 (Bd. Pat. App. & Int 1990) ; IPXL Holdings, L.L.C. v Amazon.Com, Inc., 430 F.3d 1377, 1384 (Fed. Cir. 2005).

The argument for patentability is based on new language added to the claims. This newly added language is addressed in the current rejection of record. The newly added language is not seen as rendering the claims allowable for the reasons stated in the rejection of record. No further comments are deemed as necessary.

The examiner takes notice that the actual 103 rejection involving the reference to Hassett has again not been argued on the merits. Applicant has not addressed this rejection at all as far as what Hassett has been relied upon for as a teaching, so it must be assumed to be proper because otherwise, 37 CFR 1.111 requires a showing of the errors in the rejection. No traversal has been made on the merits for the 103 rejection involving the Hassett reference.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DENNIS RUHL
PRIMARY EXAMINER